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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,514	03/17/2004	Gregory Adam Solan	2003B023	3960

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT PAPER NUMBER

1755

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/802,514	Applicant(s) SOLAN ET AL.	
	Examiner J. Pasterczyk	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) 19-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-13 and 15-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/05, 9/7/04, 7/28/04</u> | 6) <input type="checkbox"/> Other: _____ |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 15-18, drawn to a catalyst system, classified in class 502, subclass 117 inter alia.
- II. Claims 19-21, drawn to a method of polymerizing an unsaturated monomer, classified in class 526, subclass various depending on the catalyst and monomer.
- III. Claims 22-24, drawn to a method of oligomerizing an unsaturated monomer, classified in class 585, subclass various depending on the catalyst, monomer, and oligomer made.

2. The inventions are independent or distinct, each from the other because:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process of using that product, such as olefin oligomerization.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product as claimed can be used in a materially different process for using that product, such as olefin polymerization.

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Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different effects, the former to make structural solids, the latter to make e.g. lubricant additives.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Paige Schmidt, Esq., on 4/22/05, a provisional election was made with traverse to prosecute the invention of group I, claims 1-13 and 15-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 19-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The abstract of the disclosure is objected to because it is not drawn to the invention as claimed, but rather only to the compounds used in the catalyst; a representative structure would also be helpful to searchers. Correction is required. See MPEP § 608.01(b).

7. The specification is objected to because in the Experimental section the coefficients on the chemical formulae are not subscripted, and the term is “Schlenk flask/tube/what have you”, not just “schlenk” all in lower case.

8. Claims 1-5, 8 and 9 are objected to because of the following informalities: in claim 1, begin the penultimate line with --each--. In claim 2, begin line 9 with --each--. Likewise with claim 3, l. 9; claim 4, l. 9, 16 and 19-21; claim 5, l. 9, 16, 19 and 20; claim 8, l. 8 and 10-12; claim 9, l. 8, 10 and 11. In claim 13, l. 2, insert --together-- after “two X groups”. Further in claims 2-5, l. 16 of each, change “or” to --and-- and “is” to --are--. Appropriate correction is required.

9. Claims 2-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, l. 1, change “comprises” to --is--.

In claims 2-9, repeating the definitions of M, N, C and X is prolix and fails to further limit the claims since these definitions are either the conventional definitions or those found in claim 1.

Further in claims 2-9, further permitting R^6 to be a halocarbyl is inconsistent with claim 1 which only permits this to be a hydrocarbyl.

In claims 2-5, the definitions of R' where there are two R' moieties in the group are self-referential and hence circular.

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 10, 11 and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagy et al., USP 6,689,848 (hereafter referred to as Nagy).

Nagy discloses the invention as claimed (col. 1, l. 65 to col. 4, l. 38; examples).

12. Claims 1, 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al., J. Organomet. Chem., vol. 658 (2002), pp. 62-70 (hereafter referred to as Wang).

Wang discloses the invention as claimed (abstract; scheme 1 in which the imino nitrogens are substituted terminal nitrogens of the present claims and the ring nitrogens are the central and pyridyl nitrogens of the present claims).

13. Claims 1, 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lenges, WO 00/68280 (hereafter referred to as Lenges).

Lenges discloses the invention as claimed (abstract; pp. 2-3, 13; examples 6-15).

14. Claims 1, 10, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Britovsek et al., Inorg. Chim. Acta, vol. 345 (2003), pp. 279-291 (hereafter referred to as Britovsek).

Britovsek discloses the invention as claimed (p. 280, top left, formula E; fig. 3, bottom structures; p. 286, paragraph 3.3).

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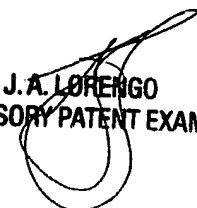
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Pasterczyk



J. A. LORENGO
SUPERVISORY PATENT EXAMINER

AU 1755

6/20/06